REMARKS

The above amendment and these remarks are responsive to the Office action of 4/2/04 by Examiner Hai V. Nguyen.

Claims 1-20 are in the case. No claims have yet been allowed.

35 U.S.C. 103

Claims 1-20 have been rejected under 35 U.S.C. 103(a) over Albers et al. (U.S. Patent 6,223,188 B1) in view of Ball et al. (U.S. Patent 6,366,933 B1).

Applicants had previously amended the claims to more clearly recite that before the head request is submitted to the server the user establishes predefined configuration parameters consisting only of one or both of data type and data size. This allows the browser to determine, based on data type and/or data size received in the head and the predefined configuration parameters, whether to issue a request for the entire file without requiring further input from the user.

In this Amendment, applicants correct an error in claim

1, so that now all claims are properly directed to applicants' invention as set forth in the preceding paragraph.

Applicants respectfully traverse the rejection of the claims, and argue that the Examiner has not established a prima facie case of obviousness, which requires that the Examiner provides

1. one or more references

2. that were available to the inventor and

3. that teach

4. a suggestion to combine or modify the references,

5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

The fourth element of the prima facie case, the suggestion to combine, must come from the prior art. It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements. [See Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 43 USPQ 2d 1294 (Fed. Cir. 1997)]. That a claimed

invention may employ known principles does not itself establish that the invention would have been obvious, particularly where those principles are employed to deal with different problems. The Examiner must consider the claim as a whole, and not piece together the claimed invention using the claims as a guide. The Federal Circuit has stated: "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. [See In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992)].

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the Examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show 'some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the

relevant teachings of the references." In re Fine, 837 F.2d
1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

A rejection under 35 U.S.C. § 103 must be based on
whether there is a teaching, motivation, or suggestion to
select and combine the references based on objective
evidence of record. Therefore, the Examiner must identify a
reason, suggestion, or motivation which would have led an
inventor to combine those references. Pro-Mold & Tool Co.
v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d
1626, 1629, (Fed. Cir. 1996).

Albers and Ball are employed to deal with different
problems.

In the case of Ball, the HEAD command is used to
retrieve the Last-Modified field from a W3 document for use
in deciding when a page has been changed. (See Ball, Col.
11, lines 62-64 and Col. 12, lines 35-46). Ball's
versioning is determined at the server, and is not based on
a profiled or predetermined configuration set up by the
customer, and the threshold is based on date of last visit,
not type or size of the file.

In the case of Albers, when the user cursor hovers over

a link, information regarding what is on that link is displayed to the user, who must then decide whether or not to download the linked material.

Thus, Albers teaches providing size and type information via visual or sound queues to a user who must then determine whether to download the linked-to file. Ball teaches a threshold based on date. Neither use, as applicants teach and claim, a predetermined, user defined configuration or profile consisting of data time and/or size.

The Examiner refers to Albers Figures 9 and 10, and Col. 9, lines 39-60 and Col. 10, lines 8-21, asserting that Albers is here teaching the concept of "a predetermined, user defined configuration parameters". But this does not reach to applicants claims, which clearly state that the predetermined, user defined configuration parameters consist of file type and/or size.

Neither Albers or Ball teach that the user inputs file type and/or size to predefine configuration parameters which will be used by the browser together with data received from a server in response to a head request to determine whether or not to issue a get request.

As argued in the previous amendment, all independent claims 1, 2, and 11-17 are directed to the concept of predefining configuration parameters based on user input consisting only of one or both of data size and data type and of using the HEAD request to determine from the file header the file size and type AND THEN ONLY WHEN the file size and file type match the predefined configuration parameters issuing a GET request to download the data portion of the file.

The Examiner provides as the motivation for combining Albers and Ball, the following:

"However, Albers does not explicitly disclose responsive to said browser determining from said data file header that said data file data type and size are in accordance with said request for data, receiving from said browser a GET request, said broswer responsive to predetermined configuration, consisting only of one or both of said data file data type and said size, not being in accordance with said request for data, not issuing said GET request to said server; and thereafter responsive to said GET request, serving to said browser data corresponding to said header. Thus the artisan would have been motivated to look into

First, the Examiner is here using applicants own
teachings to provide the motivation. The Examiner recites
applicants claim, and then states "Thus the artisan would
have been motivated..." The antecedent of "thus" is
applicants' own teaching! It is well established that the
motivation to combine must come from the prior art
references.

Second, the Examiner states that the artisan is
motivated to look for "potential methods and systems for
implementing the servicing the browser user's requests for
resources..." This is not what applicants are claiming, and
that the Examiner could find such in the Ball reference has
no relationship whatsoever to applicants claims. Certainly,
neither Ball or Albers teach, as applicants' claims all
variously recite, that a browser user predefine
configuration parameters consisting of one or both of file
type and file size, which parameters are compared in the
browser with the file type and size received from a server
in response to a HEAD request from a browser to determine at

the browser whether or not to submit a GET request to the
server to obtain the full data file.

Applicants respectfully assert that neither Albers nor
Ball teach, nor in combination teach, the invention set
forth in claims 1-20, and urges that they be allowed.

SUMMARY AND CONCLUSION

Applicants urge that the above amendments be entered and the case passed to issue with claims 1-20.

The Application is believed to be in condition for allowance and such action by the Examiner is urged. Should differences remain, however, which do not place one/more of the remaining claims in condition for allowance, the Examiner is requested to phone the undersigned at the number provided below for the purpose of providing constructive assistance and suggestions in accordance with M.P.E.P. Sections 707.02(j) and 707.03 in order that allowable claims can be presented, thereby placing the Application in condition for allowance without further proceedings being necessary.

This case has already been through a continuation and, unless allowable, it would appear that the issues are joined

for appeal. Thus, and in any event, applicants request that the amendment to claim 1 correcting the error be entered for the purpose of placing the claim in better condition for appeal.

Sincerely,

R. G. Hartmann, et al.

By

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Date: 1 June 2004

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